

### **CONDITIONAL PETITION FOR EXTENSION OF TIME**

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

### **ADDITIONAL FEE**

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

## REMARKS/ARGUMENTS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Claim 1 has been amended to specify that the at least two monophosphorus ligands are “constitutionally different.” Applicants respectfully submit that this amendment is well supported by the instant specification and does not introduce new matter.

In this regard, Applicants submit along with the accompanying information disclosure statement an excerpt from the well-known textbook, *Stereochemistry of Organic Compounds* by Ernest Eliel and Samuel Wilen, Wiley & Sons, Inc., New York, NY, 1994. In the third paragraph on page 15, a definition is given of the term “constitution” as connoting “the number, kind, *and connectivity of the atoms* in a molecule. Constitution may be represented by a two-dimensional (2D) graph in which the atoms linked to each other are connected by a bond (single, double, or triple).”

In the first paragraph on page 18, there is a discussion of “configuration,” and the teaching that “[m]olecules of *identical constitution* may yet differ in structure \* \* \* [such as] two enantiomers (nonsuperposable mirror-image structures) \* \* \*. These molecules [i.e., the two enantiomers] are said to differ in configuration.”

In short, Applicants respectfully submit that it would have been clear to persons skilled in the art that two enantiomers have the same constitution, but differ in configuration, as evidenced by the Eliel textbook.

Further, considering the instant examples, wherein numerous examples are given of compounds having monophosphorus ligands of differing constitution, Applicants respectfully submit that it would have also been clear to persons skilled in the art that, at the time the instant application was filed, Applicants had possession of the general concept of providing monophosphorus ligands of differing constitution.

Consequently, Applicants further submit that Applicants' use of the well-known term "constitution" to clarify the claims does not introduce any new matter since the concept of constitutionally different monophosphorus ligands is clearly present in the original application as filed as evidenced by the instant examples. Applicant reminds the Examiner that *ipsis verbis* support is not the only way to satisfy the written description requirement. See, e.g., *In re Anderson*, 176 USPQ 331, 336 (CCPA 1973), for the proposition that in determining whether an amendment to a claim constitutes new matter, the question is not whether the added word is a word that is used in the application as filed, but whether the concept embodied by the added word is present in the original specification. The concept of constitutionally different monophosphorus ligands is conveyed by the original specification for the reasons indicated above. Therefore, Applicants use of the term "constitutional" does not introduce new matter.

Turning to the restriction requirement, Applicants respectfully submit that the clarifying amendment to claim 1 re-establishes unity of invention. Therefore, Applicants respectfully request that the Examiner rejoin and examine claims 2, 7, 8 and 12-15.

Claim 11 was rejected under 35 USC § 112, second paragraph, as being indefinite. In response, Applicants have corrected  $\text{-C(CH}_3)_3$  in claim 11.

Claims 1, 3-6, 9 and 10 were rejected under 35 USC § 102(b) as being anticipated by Reetz et al. ("Reetz"), *Angew. Chem. Int. Ed.*, 39: 3889-3890 (2000). In response, Applicants respectfully submit that the clarifying amendment to claim 1 and, therefore, also the other claims, moots this rejection. The enantiomers 8a and 8b in the Reetz article are not "constitutionally different monophosphorus ligands" as required by the instant claims and, therefore, do not anticipate the instant claims.

Claim 11 was rejected under 35 USC § 103(a) as being obvious over Reetz. In response, Applicants respectfully submit that this rejection was dependent upon the Reetz article anticipating the basic aspects of the claimed invention, which, as shown above, is not, in fact, the case. In view of the amendment to claim 1 and, therefore, also the other claims, the Reetz article would not have rendered claim 11 *prima facie* obvious to persons skilled in the art.

Claims 1, 3-6 and 9-11 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5, 6, 7 and 10 of U.S. Patent No. 7,265,237. In response, Applicants respectfully submit that the Examiner's basis for this rejection is not properly set forth. According to the Examiner, the claims, although not identical, "are not patentably distinct from each other because the claims of the reference fail to teach the use of two different ligands." It is not clear how the reference's failure to teach the use of two different ligands renders the two sets of claims patentably indistinct. Moreover, Applicants point out that the instant claims now require the use of at least two constitutionally different monophosphorus ligands.

Further, the data in the instant specification prove the unexpected results achieved using

at least two constitutionally different monophosphorus ligands. Thus, as discussed in paragraph [0007] of the published application, US 2006/0014981, the data show that the use of at least two constitutionally different monophosphorus ligands in many cases provides higher ee values than the use of either of the corresponding homocombinations of the identical monophosphorus ligands. For example, Table 1, Entry 1, the homocombination (R)Ia/(R)Ia gave an ee of 91.8%; and Table 1, Entry 3, the homocombination (R)Ic/(R)Ic gave an ee of 92.0%. In contrast, surprisingly and unexpectedly, Table 1, Entry 16, the heterocombination (R)Ia/(R)Ic gave an ee of 97.9%. In other words, the heterocombination surprisingly and unexpectedly gave a higher ee than either homocombination alone.

Consequently, the instant claims are, in fact, patentably distinct from the patented claims.

Claims 1, 3-6 and 9-11 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5, 6, 7 and 10 of U.S. Patent No. 7,265,237 in view of Reetz. In response, Applicants point out that Reetz does not teach the use of at least two constitutionally different monophosphorus ligands, as instantly claimed, so the combination of the patent and the Reetz article does not make out a *prima facie* case of obviousness-type double patenting of the instant claims.

Further, the data in the instant specification prove the unexpected results achieved using at least two constitutionally different monophosphorus ligands. Thus, as discussed in paragraph [0007] of the published application, US 2006/0014981, the data show that the use of at least two constitutionally different monophosphorus ligands in many cases provides higher ee values than the use of either of the corresponding homocombinations of the identical monophosphorus

ligands. For example, Table 1, Entry 1, the homocombination (R)Ia/(R)Ia gave an ee of 91.8%; and Table 1, Entry 3, the homocombination (R)Ic/(R)Ic gave an ee of 92.0%. In contrast, surprisingly and unexpectedly, Table 1, Entry 16, the heterocombination (R)Ia/(R)Ic gave an ee of 97.9%. In other words, the heterocombination surprisingly and unexpectedly gave a higher ee than either homocombination alone.

Consequently, the instant claims are, in fact, patentably distinct from the patented claims.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,  
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